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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,658	11/24/2003	Michael E. Lopata	04637/0200427-US0	7662
7278	7590	06/27/2005	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			NOVOSAD, CHRISTOPHER J	
			ART UNIT	PAPER NUMBER
			3671	

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/722,658

Applicant(s)

LOPATA, MICHAEL E.

Examiner

Christopher J. Novosad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 4, the recitation “appropriate size” is indefinite since it is unclear as to exactly what is supposed to constitute an “appropriate size” since “appropriate” is a relative term.

In claim 1, line 5, the recitation “the said” is redundant.

It is unclear as to exactly what “any undesirable materials” recited in line 3 of claims 11 and 17 are supposed to be since “undesirable” is a relative term.

In claim 13, line 2, the recitation “said plows” lacks proper antecedent basis.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Scudder.

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With respect to claim 1, Scudder shows a movable unit 10 for screening excavated material that protectively covers or encases one or more utilities 100 in an excavated trench 12, comprising:

a screening member 36,38 mounted to the unit 10 and having at least one screen 36 or 38 with a plurality of openings (col. 5, lines 29 and 30) of appropriate size, with the excavated material passing through the openings (col. 5, lines 29 and 30) of the at least one screen 36 or 38 to deposit onto and cover and encase the utility 100 or utilities being installed in the trench 12 as the unit 10 moves.

As to claim 3, a plow 18 for sweeping via 24 onto the top (unnumbered) of the screening member 36,38 excavated material 74,76 lying along at least one side of the trench 12.

Regarding claim 4, the screening member 36,38 is mounted to the movable unit 10 with a downward slope (Fig. 1) away from the direction of movement of the movable unit 10.

With respect to claim 5, a shaker unit (col. 4, lines 25-29) is connected to the screening member 36,38 to shake the screening member 36,38 to facilitate passage of particles through the openings (col. 5, lines 29 and 30) of the at least one screen 36 or 38.

As to claim 6, the screening member 36,38 comprises a plurality of screens 36,38 spaced apart, one 36 above the other 38, with the screens 36,38 having progressively smaller openings from the top to bottom of the screening member 36,38 to deposit in the trench 12 layers (unnumbered) of the material having progressively larger particle size from the bottom (unnumbered) to the top (unnumbered) of the trench 12.

Regarding claim 7, the screening member 36,38 is mounted to the movable unit 10 with a downward slope away from the direction of movement of the movable unit 10.

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With respect to claim 8, the trailing end (unnumbered) of each screen 36,38 of the screening member 36,38 extends out further in a direction rearward of the movable unit 10 movement than the screen 38 immediately below it 36.

As to claim 9, a shaker unit (col. 4, lines 25-29) is connected to the screening member 36,38 to shake the screening member 36,38 to facilitate passage of particles through the openings (col. 5, lines 29 and 30) of each of the plurality of screens 36,38.

Regarding claim 10, the screening member 36,38 comprises a first screen 36 as an upper screen 36 and a second screen 38 as a lower screen 38, the trailing end 42 of the first screen 36 extending further in a rearward direction (left side of Fig. 1) of the unit 10 than the trailing end 44 of the second screen 38, the second screen 38 having openings of a smaller size than the openings of said first screen 36, whereby a first layer 80 of smallest size particles 80 passing through the openings of the first 36 and second 38 screens are deposited on the at least one utility 100 in the trench 12, a second layer 78 of particles 78 of a size smaller than the openings of the first screen 36 but larger than the openings of the second screen 38 that slides off of the top surface (unnumbered) of the second screen 38 onto the first layer 80 of particles 80, and a third layer 76 of particles 76 of a size larger than the openings of the first screen 36 that slide off of the top surface (unnumbered) of the first screen 36 onto the second layer 78 of particles.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivard in view of Scudder.

With respect to claim 1, Rivard shows a movable unit (Figs. 1 and 2) for excavated material (col. 6, lines 15 and 16) that protectively covers or encases one or more utilities 6 in an excavated trench 18, comprising:

with the excavated material (col. 6, lines 15 and 16) to deposit onto and cover and encase the utility 6 or utilities being installed in the trench 18 as the unit (Figs. 1 and 2) moves.

As to claim 2, Rivard shows a guide 30,36-38 for placing a length (unnumbered) of at least one utility 6 onto which the material (col. 6, lines 15 and 16) is deposited in the trench 18 as the unit (Figs. 1 and 2) moves.

Regarding claim 3, Rivard shows a plow 61,61A for sweeping excavated material (col. 6, lines 15 and 16) lying along at least one side of the trench 18.

With respect to claim 11, a vertical plate 32,33 (Figs. 1-3) is mounted on each side of the movable unit (Figs. 1 and 2) to support a wall of the trench 18 and to prevent any undesirable materials from falling onto the at least one installed utility 6 being covered by the layers 41,2 of the particles.

As to claim 12, a plow 61,61A (Fig. 3) is for sweeping excavated material (col. 6, lines 15 and 16) lying along at least one side of the trench 18.

Regarding claim 13, note a means 27 for indirectly adjusting the height of the plows 61,61A relative to the top (unnumbered) of the trench 18.

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With respect to claim 17, a vertical plate 32,33 (Figs. 1-3) is mounted on each side of the movable unit (Figs. 1 and 2) to support a wall of the trench 18 and to prevent any undesirable materials from falling onto the at least one installed utility 6 being covered by the layers 41,2 of the particles.

The claims distinguish over Rivard in requiring (1) a screening member to be mounted to the unit and to have at least one screen with a plurality of openings of appropriate size with material passing through the openings of the at least one screen (as required in claim 1); (2) the material deposited into the trench to be screened (as required in claim 2); (3) excavated material to be swept onto the top of the screening member (as required in claim 3); (4) the screening member to comprise a first screen as an upper screen and a second screen as a lower screen, the trailing end of the first screen extending further in a rearward direction of the unit than the trailing end of the second screen, the second screen having openings of a smaller size than the openings of the first screen, whereby a first layer of smallest size particles passing through the openings of the first and second screens are deposited on the at least one utility in the trench, a second layer of particles of a size smaller than the openings of the first screen but larger than the openings of the second screen that slides off of the top surface of the second screen onto the first layer of particles, and a third layer of particles of a size larger than the openings of the first screen that slide off of the top surface of the first screen onto the second layer of particles (as required in claims 10 and 16); (5) the screening member is mounted to the movable unit with a downward slope away from the direction of movement of the movable unit (as required in claim 14); (6) a shaker unit connected to the screening member to shake the screening member to

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facilitate passage of particles through the openings of the first and second screens (as required in claim 15).

Scudder shows (1) a screening member 36,38 mounted to the unit 10 and having at least one screen 36 or 38 with a plurality of openings (col. 5, lines 29 and 30) of appropriate size with the material passing through the openings (col. 5, lines 29 and 30) of the at least one screen 36 or 38 (as required in claim 1); (2) the material deposited into the trench 12 being screened (as required in claim 2); (3) excavated material 74,76 to be swept via 24 onto the top (unnumbered) of the screening member 36,38 (as required in claim 3); (4) the screening member 36,38 comprising a first screen 36 as an upper screen 36 and a second screen 38 as a lower screen 38, the trailing end 42 of the first screen 36 extending further in a rearward direction (left side of Fig. 1) of the unit 10 than the trailing end 44 of the second screen 38, the second screen 38 having openings of a smaller size than the openings of the first screen 36, whereby a first layer 80 of smallest size particles 80 passing through the openings of the first 36 and second 38 screens are deposited on the at least one utility 100 in the trench 12, a second layer 78 of particles 78 of a size smaller than the openings of the first screen 36 but larger than the openings of the second screen 38 that slides off of the top surface (unnumbered) of the second screen 38 onto the first layer 80 of particles 80, and a third layer 76 of particles 76 of a size larger than the openings of the first screen 36 that slide off of the top surface (unnumbered) of the first screen 36 onto the second layer 78 of particles (as required in claims 10 and 16); (5) the screening member 36,38 is mounted to the movable unit 10 with a downward slope away from the direction of movement of the movable unit 10 (as required in claim 14); (6) a shaker unit (col. 4, lines 25-29) connected to the screening member 36,38 to shake the screening member 36,38 to facilitate passage of



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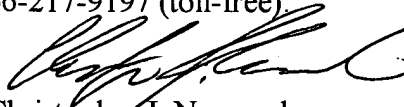
particles through the openings (col. 5, lines 29 and 30) of the first and second screens 36 or 38 (as required in claim 15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the unit of Rivard with the structure noted of Scudder for protection of the utility.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher J. Novosad whose telephone number is 571-272-6993. The examiner can normally be reached on Monday-Thursday 5:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached at 571-272-6998. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Christopher J. Novosad  
Primary Examiner  
Art Unit 3671

June 24, 2005